



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,511	11/08/2001	John Ruckart	36968/262637 (BS 001256)	5393

23552 7590 09/30/2003
MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

TRAN, QUOC DUC

ART UNIT	PAPER NUMBER
----------	--------------

2643

4

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,511

Applicant(s)

RUCKART ET AL.

Examiner

Quoc D Tran

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/008,888. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-37 of instance application is similar in scope to claims 1-16 of application 10/008,888 with obvious wording variations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

3. Claims 3 and 22 are objected to because of the following informalities: the acronym MAC must spelled out at least once in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2643

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9, 19-27 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Lesley (6,188,752).

Consider claim 1, Lesley teaches a method for purchasing prepaid communications credit, comprising: receiving an origination number; receiving a code, wherein the code corresponds to a predefined payment amount for prepaid credit; and crediting an account associated with the origination number with the predefined payment amount for prepaid credit (col. 9 line 32 – col. 10 line 22).

Consider claim 2, Lesley teaches the method wherein the origination number comprises a phone number (col. 7 lines 36-43).

Consider claim 3, Lesley teaches the method wherein the origination number comprises media access control (MAC) address (col. 4 lines 32-48). It should be noted that the data network such as Ethernet is inherently comprise MAC address since it is the ID address.

Consider claim 4, Lesley teaches the method further comprising deducting the cost of a communications connection from the payment amount for prepaid credit in the account (col. 6 lines 4-42).

Consider claim 5, Lesley teaches the method wherein the communications connection comprises a phone call (col. 4 lines 32-48).

Consider claim 6, Lesley teaches the method wherein the communications connection comprises a computer network connection (col. 4 lines 32-48).

Art Unit: 2643

Consider claim 7, Lesley teaches the method further comprising: if a predefined condition is detected, deducting the cost of a communications connection from the payment amount for prepaid credit in the account (col. 2 lines 14-29; col. 5 lines 51-58; col. 6 lines 4-42).

Consider claim 8, Lesley teaches the method wherein the predefined condition comprises that the communications connection originates from the received origination number (col. 7 lines 5-12).

Consider claim 9, Lesley teaches the method wherein the predefined condition comprises that the communications connection originates from the received origination number and the communications connection requires payment (col. 7 lines 5-12; col. 8 lines 1-25).

Consider claim 19, Lesley teaches the method further comprising: receiving a plurality of phone numbers; and if a phone call originates from any of the received plurality of phone numbers, deducting the cost of the phone call from the payment amount for prepaid credit in the account (col. 6 lines 4-42; col. 7 lines 1-25).

Consider claim 20, Lesley teaches a system for prepaid communications, comprising: a computer readable medium comprising: a first set of instructions for receiving an origination number; a second set of instructions for receiving a code, wherein the code corresponds to a predefined payment amount for prepaid credit; and a third set of instructions for crediting an account associated with the origination number with the predefined payment amount for prepaid credit (col. 9 line 32 – col. 10 line 22).

Consider claim 21, Lesley teaches the system wherein the origination number comprises a phone number (col. 7 lines 36-43).

Art Unit: 2643

Consider claim 22, Lesley teaches the system wherein the origination number is comprises MAC address (col. 4 lines 32-48). It should be noted that the data network such as Ethernet is inherently comprise MAC address since it is the ID address.

Consider claim 23, Lesley teaches the system further comprising a fourth set of instructions for deducting the cost of a communications connection from the payment amount for prepaid credit in the account if a predefined condition is detected (col. 6 lines 4-42).

Consider claim 24, Lesley teaches the system wherein the communications connection comprises a phone call (col. 4 lines 32-48).

Consider claim 25, Lesley teaches the system wherein the communications connection comprises a computer network connection (col. 4 lines 32-48).

Consider claim 26, Lesley teaches the system wherein the predefined condition comprises that the communications connection originates from the received origination number (col. 7 lines 5-12).

Consider claim 27, Lesley teaches the system wherein the predefined condition comprises that the communications connection originates from the received origination number and the communications connection requires payment (col. 7 lines 5-12; col. 8 lines 1-25).

Consider claim 37, Lesley teaches the system further comprising: a twelfth set of instructions for receiving a plurality of phone numbers; and a thirteenth set of instructions for deducting the cost of the phone call from the payment amount for prepaid credit in the account if a phone call originates from any of the received plurality of phone numbers (col. 6 lines 4-42; col. 7 lines 1-25).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-12 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lesley (6,188,752) in view of Jones et al (6,195,422).

Consider claims 10 and 28, Lesley did not clearly suggest wherein the predefined condition comprises detecting a predefined destination number. However, Jones et al teach a pre-paid telecommunication services that provided restriction to a particular destination (col. 6 lines 10-36). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to utilize the teaching of Jones et al into view of Lesley in order to provide user to the flexibility of controlling their usages.

Consider claims 11 and 29, Jones et al teach wherein the destination number comprises a phone number (col. 6 lines 10-36).

Consider claims 12 and 30, Lesley suggest discontinuing the communications connection if the cost of the communications connection is greater than the payment amount for prepaid credit in the account. Lesley did not clearly suggest the system and method further comprising if a communications connection originates from the received origination number and the received origination number comprises a toll blocked phone number. However, Jones et al teach a pre-paid telecommunication services that provided restriction to a particular destination (col. 6 lines 10-36). Therefore, it would have been obvious to one of the ordinary skill in the art at the time

Art Unit: 2643

the invention was made to utilize the teaching of Jones et al into view of Lesley in order to provide user to the flexibility of controlling their usages.

8. Claims 13-14 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lesley (6,188,752) in view of Dowens (6,122,354).

Consider claims 13 and 31, Lesley did not suggest the system and method further comprising charging the cost of the communications connection that exceeds the payment amount for prepaid credit in the account to the owner of the origination number. However, Dowens teaches a prepaid calling card system and method that enable the call to continue after the calling card limit has exhausted and bill the remaining charges to the party that accepts the charges (abstract; col. 2 lines 11-21). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Dowens into view of Lesley in order to allow the on going call to extend.

Consider claims 14 and 32, Lesley did not suggest the system and method further comprising if a communications connection originates from the received origination number and the received origination number is not a toll blocked phone number, charging the cost of the communications connection that exceeds the payment amount for prepaid credit in the account to the owner of the origination number. However, Dowens teaches a prepaid calling card system and method that enable the call to continue after the calling card limit has exhausted and bill the remaining charges to the party that accepts the charges (abstract; col. 2 lines 11-21). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Dowens into view of Lesley in order to allow the on going call to extend.

Art Unit: 2643

9. Claims 15-18 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lesley (6,188,752) in view of Lorsch (5,903,633).

Consider claims 15 and 33, Lesley did not suggest the method and system further comprising receiving the code from a retail establishment. However, Lorsch teaches a method and system for calling card activation including receiving PIN number for the calling card (abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Lorsch into view of Lesley in order to minimize loss of card value prior to activation of the calling card.

Consider claims 16 and 34, Lesley did not suggest the method and system further comprising receiving the code from a magnetic strip on a card. However, Lorsch teaches a method and system for calling card activation including receiving PIN number for the calling card (abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Lorsch into view of Lesley in order to minimize loss of card value prior to activation of the calling card.

Consider claims 17 and 35, Lesley did not suggest the method and system further comprising receiving the code through a voice mail system. However, Lorsch teaches a method and system for calling card activation including receiving PIN number for the calling card (abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Lorsch into view of Lesley in order to minimize loss of card value prior to activation of the calling card.

Consider claims 18 and 36, Lesley did not suggest the method and system further comprising receiving the code through a computer network. However, Lorsch teaches a method

Art Unit: 2643

and system for calling card activation including receiving PIN number for the calling card (abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Lorsch into view of Lesley in order to minimize loss of card value prior to activation of the calling card.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Facsimile responses should be faxed to:

(703) 872-9314

Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive
Arlington, VA., Sixth Floor (Receptionist)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Quoc Tran** whose telephone number is **(703) 306-5643**. The examiner can normally be reached on Monday-Thursday from 8:00 to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Curtis Kuntz**, can be reached on **(703) 305-4708**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600** whose telephone number is **(703) 306-0377**.



Quoc D. Tran
Patent Examiner AU 2643
September 21, 2003